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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/182,825	10/29/1998	WARNER R.T. TEN KATE	PHN-16.695	2426

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EXAMINER

HONG, STEPHEN S

ART UNIT PAPER NUMBER

2178

DATE MAILED: 04/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/182,825

Applicant(s)

Ten Kate

Examiner

Stephen Hong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 21, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-44 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Part III DETAILED ACTION

1. This action is responsive to communications: Request for RCE and amendment filed on January 21, 2003 to the application, filed on 10/29/1998.
2. In the preliminary amendment claims 43 and 44 have been added. Accordingly, claims 28-44 are pending in the case. Claims 28, 35, 36, 37 and 43 are independent claims.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 28-34 remain rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The claims are not directed to statutory subject matter because the claimed subject matter:

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- (1) does not fall within one of the four statutory classes of inventions under § 101;
and/or
- (2) falls within the mere idea or abstract intellectual concept exception to § 101;
and/or
- (3) falls, by analogy, within the printed matter exception to § 101.

The claimed "data structure" is non-functional data structure which is considered non-statutory subject matter by analogy to the "printed matter" exception under § 101. See In re Miller, 164 USPQ 46, 49 (CCPA 1969). Like printed matter, a data structure, in and of itself, is merely an arrangement of data and nothing more. Furthermore, claims drawn to printed matter may be non-statutory even though the claims recite the structure on which the printed matter is printed:

The mere arrangement of printed matter on a sheet or sheets of paper, in book form or otherwise, does not constitute "any new and useful art, machine, manufacture, or composition of matter," or "any new and useful improvements thereof," as provided in section 4886, of the Revised Statutes [the predecessor to 35 U.S.C. § 101].

(emphasis in original). In re Russell, 9 USPQ 181, 182 (CCPA 1931). At best, the claims as a whole describe a data structure stored in a computer system. Accordingly, like printed matter "stored" on a sheet of paper, a data structure stored in a computer system fails to present statutory subject matter.

The claims recite the limitations directed to describing attributes of the "coded presentation", "sub-presentation", etc. These representations are merely the descriptions of

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multimedia data, which are "non functional" data structures . The claims do not recite any limitations of "manipulating" the data structures to achieve "practical application." Therefore, the claimed recitations of describing these representations are merely "non functional" data structures, which are not statutory. Although the sub-presentation program segment is embodied on a "computer readable medium", the sub-presentation program segment only contains non-functional data structures such as "play-out specification", "reference timing", etc. In order to make the claim as a whole statutory, the computer readable medium must also contain functional data structures, for example, "instructions for playing out the sub-presentation using the playout-specification." Without such functional data structures, the current claims basically claim a computer readable medium containing timing data.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371⁹ of this title before the invention thereof by the applicant for patent.

7. Claims 28-32, 34-40 and 42 remain rejected under 35 U.S.C. 102(e) as being anticipated by Moorby et al., U.S. Pat. No. 5,892,507, 4/99 (filed on 4/6/95).

As per Claims 28-32, 34-40 and 42, Moorby teaches the use of a sub-presentation which comprises a plurality of sequence of presentation (FIG.11a-11c), wherein the sequence

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of presentation are presented one after the other, and simultaneously with respect to each other (FIG.12a; col.12, lines 7-35), wherein the start and duration are also specified (col.11, lines 45-55, "...the length of a TimeLine track and the Icons along it depict the duration..."), and further shows that the interface of the sub-presentation provides a time references (see FIG.12b).

Moorby further teaches that the sub-presentation provides a sub-presentation priority specifying a priority with respect to presenting the subpresentation (FIG.1 shows the priority direction of the sub-presentations along the storyline).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103^o and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 33 and 41 remain and 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moorby et al. in view of Gudmundson et al., U.S. Pat. No 5,680,619, 10/97 (filed 4/95).

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As per dependent claims 33 and 41, Moorby does not explicitly teach that the play-out specification includes a location specification specifying a location of the presentation element when presented and wherein interface of the sub-presentation provides a location frame of reference relative to which the location specification for the presentation element is specified. This feature, however, is shown by Gudmundson. Like, Moorby, Gudmundson also teaches authoring the multimedia presentation using the sub-presentation groups, called “containers”(col.8, lines 25-67). Note that within a container includes the sequence of presentations, and also contains the location attributes (e.g., FIG.16(c)) , all of which are interfaced by the container’s object interface (col.16, lines 53+). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have incorporated Gudmundson’s feature into Moorby, since a person of ordinary skill would have appreciated that would have provide a user of the Moorby’s editor the ability to edit the layout information in addition to the timing information.

As per independent claim 43, Moorby teaches the use of a sub-presentation which comprises a plurality of sequence of presentation (FIG.11a-11c), wherein the sequence of presentation are presented one after the other, and simultaneously with respect to each other (FIG.12a; col.12, lines 7-35), wherein the start and duration are also specified (col.11, lines 45-55, “...the length of a TimeLine track and the Icons along it depict the duration...”), and further shows that the interface of the sub-presentation provides a time references (see FIG.12b). Moorby further teaches that step of accessing a medium, readable by the device and

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on which the coded multi-media presentation is stored (col.2, lines 34-36, showing the Windows-based computer implementation).

However, Moorby does not appear to explicitly teach the use of a self-contained, sub-presentation data structures, and using the structure for retrieving at least one play-out specification portion from a first location in the data structure, which play-out specification portion specifies timing behavior of at least one respective presentation element within the data structure; and responsive to the play-out specification, retrieving the at least one respective presentation element from a second location in the data structure. In other words, Moorby's presentation elements provide the playout specification including the timing information, but Moorby does not appear to disclose that the playout specification and the playout elements are necessarily encapsulated in a self-contained data structure. Nevertheless, the use of the self-contained data structure for storing and accessing the presentation elements are well known as evidenced by Gudmundson. Like, Moorby, Gudmundson also teaches authoring the multimedia presentation using the sub-presentation groups, called "containers"(col.8, lines 25-67). Note that within a container includes the sequence of presentations, and also contains the location attributes (e.g., FIG.16(c)) , all of which are interfaced by the container's object interface (col.16, lines 53+). Therefore, Gudmundson's object container (col.8, line 28) discloses the use of the self-contained data structures. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have incorporated Gudmundson's feature into Moorby, since a person of ordinary skill would have appreciated that would have provide

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a user of the Moorby's editor the ability to edit the layout information in addition to the timing information.

As per dependent claim 43, which depends on claim 42, Moorby in view of Gudmundson discloses that the sub-sub-presentation data structure comprising at least one play-out specification sub-sub-structure and a plurality of presentation element sub-sub-structures, since Gudmundson teaches that the "Hierarchical Encapsulation" (col.8, line 27) is being used for the object containers storing the multimedia playout data. Therefore, Gudmundson teaches the use of sub-sub data structures under the hierarchy of the sub-data structures for the multimedia presentation.

Response to Arguments

10. Applicant's arguments filed January 21, 2003 have been fully considered but they are not persuasive.

On page 3 of the argument, with respect to the rejection under 35 USC 101, Application argues that "A play -out specification is recited which indicates how a presentation is to be played. This is functional recitation. The play-out specification has a function with respect to the presentation element." Examiner disagrees. The claimed data structures are only a play specification without out any active steps that perform a function. By analogy, the play out specification is like the musical notes store on a medium. It has "functionality" meaning that it has utility, but the notes themselves do not perform any functions. There must

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be a separate functional data structure that accesses the notes to play the sound (e.g, send MIDI commands). Similarly, the play out specification does not “perform” any functions by itself; it merely contains information that is to be used when the functions are being performed.

Therefore, it is clearly a non-functional data structure.

On pages 3 and 4, Applicant asserts that “examiner fails to use the definition of ‘presentation element’ from the specification.” However, it should be noted that the argument is not being followed by what the definition of the term must be according to the specification. Therefore, Examiner disagrees with the argument. On page 1, line 21 of the specification, Applicant states the following about the “presentation element”: “The presentation *may* include presentation elements comprising text, audio, video or an image.” If this is how the presentation element is defined, Moorby clearly teaches that. Further, if Applicant wishes to, he/she can explicitly point out where and how the phrase “presentation element” is defined in the specification. However, Applicant should be aware that the “definition” should not be confused with the preferred embodiments. That is, using the Applicant’s own example, just because the Applicant’s preferred embodiment uses “four legs” to build a chair, that does not mean that the Applicant has defined the chair to must have four legs. Similarly, it can hardly be construed as a definition, when the Applicant states that the “presentation element can be regarded as an elementary item that is to be presented (page 1 of the specification, line 23)”, since it is suggesting that it “can be regarded” or maybe it can not be regarded.

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Applicant can be his or her own lexicographer. Therefore, if in fact, the Applicant has clearly defined the term "presentation element" and can demonstrate that, examiner will use the definition. However, there does not appear to be the explicit definition that is contradictory to the examiner's interpretation of the term in applying the prior art.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231


or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-9724 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).



Stephen Hong

Primary Examiner

April 18, 2003